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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,073	05/27/1999	MICHAEL F. GUHEEN	AND1P103	7477

22908	7590	11/22/2005

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EXAMINER
POND, ROBERT M

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/322,073	GUHEEN ET AL.
	Examiner	**Art Unit**	
	Robert M. Pond	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET·TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-10 and 12-17* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-10 and 12-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☒ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. *20051115*.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee

set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR 1.114,

and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the

previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 16 September 2005 has been entered.

Response to the Amendment

The Applicant amended independent Claims 1, 9, and 17. All pending claims

(1, 2, 4-10, and 12-17) were examined in this non-final office action.

Response to the Arguments

Pertaining to Rejection under 35 USC 101

The Applicant amended claims to overcome rejection. Rejection under 35

USC 101 is withdrawn.

Pertaining to Rejection under 35 USC 103(a), Claims 1, 2, 4-10, and 12-17

Applicant's arguments filed 18 August 2005 have been fully considered but

they are not persuasive. The Applicant can overcome rejection by amending

claim language as proposed the Examiner as noted under section "Allowable Subject Matter."

In response to this office action, the Applicant should amend the specification as necessary to reflect changes in drawings, correct typographical errors, incorporate reference characters or delete reference characters to ensure accuracy with current drawings and/or changes to the drawings.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or

1.321(d) may be used to overcome an actual or provisional rejection based on a

nonstatutory double patenting ground provided the conflicting application or

patent either is shown to be commonly owned with this application, or claims an

invention made as a result of activities undertaken within the scope of a joint

research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully

comply with 37 CFR 3.73(b).

1.   **Claims 1, 9, and 17 are rejected on the grounds of nonstatutory double**

patenting over claims 1 and 2 of U. S. Patent No. 6,721,713 since the claims,

if allowed, would improperly extend the "right to exclude" already granted

in the patent.

The subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the application are

claiming common subject matter, as follows: method, system, and program

product for identifying from a network framework, at least one business alliance

via indicia coding associated with a network component.

Furthermore, there is no apparent reason why applicant was prevented from

presenting claims corresponding to those of the instant application during

prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

2.   **Claims 1, 9, and 17 are rejected on the grounds of nonstatutory double patenting over claims 1 and 10 of U. S. Patent No. 6,957,186 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: method, system, and program product for identifying from a network framework, at least one business alliance via indicia coding associated with a network component that will provide an improvement.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3.   **Claims 1, 9, and 17 are rejected on the grounds of nonstatutory double patenting over claims 1, 7, and 13 of U. S. Patent No. 6,615,166 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

The subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the application are

claiming common subject matter, as follows: method, system, and program

product for identifying from a network framework, at least one business alliance

via indicia coding associated with a network component that will provide an

improvement.

Furthermore, there is no apparent reason why applicant was prevented from

presenting claims corresponding to those of the instant application during

prosecution of the application which matured into a patent. See *In re Schneller*,

397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4.   **Claims 1, 9, and 17 are rejected on the grounds of nonstatutory double**

patenting over claims 1, 10, and 19 of U. S. Patent No. 6,536,037 since the

claims, if allowed, would improperly extend the "right to exclude" already

granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the application are

claiming common subject matter, as follows: method, system, and program

product for identifying from a network framework, at least one business alliance

via indicia coding associated with a network component that will provide an

improvement. Please note: omissions and redundancies in terms of network

components do not necessarily indicate a need for improvement. Inherent in the

claimed invention of the instant application is the capability to identify redundant network components and omissions.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5.   **Claims 1, 9, and 17 are rejected on the grounds of nonstatutory double patenting over claims 1, 9, and 17 of U. S. Patent No. 6,519,571 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: method, system, and program product for identifying from a network framework, at least one business alliance via indicia coding associated with a network component that will provide an improvement. Please note: the claimed invention of the instant application develops a profile of a customer's network framework and targets network components for sale.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

6.   **Claims 1, 9, and 17 are rejected on the grounds of nonstatutory double**

patenting over claims 1, 10, and 19 of U. S. Patent No. 6,473,794 since the

claims, if allowed, would improperly extend the "right to exclude" already

granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the application are

claiming common subject matter, as follows: method, system, and program

product for identifying from a network framework, at least one business alliance

via indicia coding associated with a network component that will provide an

improvement. Please note: the claimed invention of the instant application

develops a profile of a customer's network framework and targets network

components for sale.

Furthermore, there is no apparent reason why applicant was prevented from

presenting claims corresponding to those of the instant application during

prosecution of the application which matured into a patent. See *In re Schneller*,

397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7.   **Claims 1, 9, and 17 are provisionally rejected on the ground of**

nonstatutory double patenting over claims 1, 10, and 19 of copending

Application No 10/662,037. This is a provisional double patenting rejection

since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the

referenced copending application and would be covered by any patent granted

on that copending application since the referenced copending application and the

instant application are claiming common subject matter, as follows: method,

system, and program product for identifying from a network framework, at least

one business alliance via indicia coding associated with a network component.

Furthermore, there is no apparent reason why applicant would be prevented

from presenting claims corresponding to those of the instant application in the

other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210

(CCPA 1968). See also MPEP § 804.

Allowable Subject Matter

8.   **Claims 1, 9, and 17 would be allowable if rewritten or amended to**

overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in

this Office action.

Pertaining to claim 1

Amend claim 1 to read as follows for claim element (a):

(a) determining, by a processor <u>executing logic</u>, an ....

Amend claim 1 to read as follows for claim elements (b)-(h):

( ) ...., by the processor <u>executing said logic</u>, ...

Pertaining to claim 9

Amend claim 9 to read as follows for claim element (a):

(a) a code segment <u>executable on a processor</u> that determines ....

Amend claim 9 to read as follows for claim elements (b)-(h):

( ) a code segment <u>executable by said processor</u> that....

Pertaining to claim 17

Amend claim 17 to read as follows for all claim elements (c)-(j):

( ) logic <u>executable by said processor</u> ....

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.   **Claims 1-2, 4, 8, 9, 10, 12, and 16-17 are rejected under 35 USC 103(a) as**

being unpatentable over Ruffin et al. (Paper #10, US 6,249,769, hereinafter

referred to as "Ruffin"), in view of PR Newswire (Paper #20050512, PTO-

892, Item: U).

Ruffin teaches an automated method for evaluating particular aspects of a

business enterprise's environment and information technology (IT) infrastructure.

(please see at least title; abstract; col. 1, line 1-22). Ruffin further teaches:

- *Determining an existing network framework:* determination of any type of business solution offered by a solutions provider, be it in the area of information technology (IT); use IT in the form of an automated set of electronic questionnaires tied to modeling tools and a knowledge base used to assist in addressing issues; the ideal automated solution enables the implementation of a series of assessments processes designed to ensure that the proper analysis is conducted; software programs for determining factors such as architecture; determining applications in the framework (e.g. e-business, ERP) (please note the examiner's interpretation: tools and processes used in determining e-business applications or ERP application would determine web-based applications) (see at least col. 3, lines 1-25; col. 4, lines 40-50; col. 5, lines 35-67).

- *Defining a plan for selling at least one of products or services:* qualifying a prospective customer (see at least col. 2, lines 5-29); a tool further comprises services for providing a sampling of the beneficial results which the customer may expect from the proffered solution (see at least col. 3, lines 49-54); the opportunity tool set generates business solution deliverables including a proposal for the enhancement of the information technology partition in accordance with the requirements articulated by the customer (see at least col. 4, lines 53-58).

- *Determining a list of targeted components related to improvements:* ordered listing of potential projects (see at least col. 7, lines 36-65);

identifying "islands of IT," and servers for consolidation (please note the
server consolidation example identifies the existence of Unix-based
servers Type 1 servers, and the absence of an additional S/390 Type 2
servers (see at least Fig. 6 (601-616); col. 10, line 29 through col. 12, line
17).

- *Determining a listing of necessary products or services (at least one):*
  generating a business deliverable in the form of a proposal (see at least
  col. 7, lines 66 through col. 8, line 8); matching the business entity's <u>needs</u>
  to a set of IT solutions as related to improvements (see at least abstract;
  Fig. 8 (806); col. 12, lines 26 through col. 15, line 45; col. 23, lines 15-16).
- *Presenting a legend:* pictorial representation featuring indicia coding with
  respect to products solution (see Fig. 7 (700); col. 12, lines 18-25).

Ruffin teaches all the above as noted under the 103(a) rejection and teaches
a) providing consulting services to assess and support information technology
frameworks, and b) as examples, proposing IBM products (please note: IBM is
not the only game in town- a plurality of business entities provide products that
compete against IBM), but does not disclose at least one identified business
alliance among a plurality of business entities associated with the targeted
components. PR Newswire teaches Algorithmics' press release announcing an
alliance with other business comprising AMS, Deloitte & Touche Consulting
Group, Ernst & Young, and IBM. PR Newswire teaches the alliance as providing
additional IT project resources necessary to meet the needs of a complex IT risk

management system project (U: see at least pages 1 and 2). Therefore it would

have been obvious to one of ordinary skill in the art at time of the invention to

modify the method of Ruffin to identify at least one identified business alliance

among a plurality of business entities in a presentation as taught by PR

Newswire, in order to promote to potential customers the expanded suite of

available services, products, and resources available to the customer via the

alliance, and thereby attract customers to the service.

Ruffin and PR Newswire teach all the above as noted under the 103(a)

rejection and further teach a) profiling the prospective customer's existing

information technology environment, b) software programs for determining

factors such as architecture, c) targeting existing components for modification,

and d) providing an illustration to the prospect of a targeted component (e.g. the

advantages of a Type 2 server (IBM S/390) over a Type 1 (UNIX OS servers)

(see at least Fig. 7 (700); col. 3, lines 45-56; col. 4, lines 40-50; col. 11, lines 1-2;

col. 12, lines 18-25; col. 22, lines 48-51). Ruffin and PR Newswire, however, do

not disclose displaying a pictorial representation of the existing network

framework. It would have been obvious to one of ordinary skill in the art at time of

the invention to modify the method of Ruffin et al. to display a pictorial

representation of the existing network framework, since it is well within the skill to

ascertain that displaying network frameworks as a pictorial representation using

software programs to visually represent a network framework is ubiquitous in the

IT industry, and therefore serves as a visual presentation aid to help a customer comprehend a proffered solution.

Ruffin and PR Newswire teach all the above as noted under the 103(a) rejection and further teach a) an automated process to ensure the prospective customer is briefed on relevant available services solutions, b) a tool comprising a database including sets of solution services and products associated with different types of business service or solution scenarios, and c) presenting solutions that modify the prospect's existing IT infrastructure. Ruffin and PR Newswire, however, do not disclose modifying the pictorial representation by indicia coding the targeted components. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the framework pictorial representation as noted above with indicia coding, since it is well within the skill to ascertain that indicia coding the targeted components associates the targeted components with solution services and products being recommended by the solutions provider, and therefore serves as a visual presentation aid to help the customer to better comprehend a proffered solution.

Pertaining to Claims 9-10, 12, and 16

Ruffin and PR Newswire teach the use of software running on a computer to automate the selling of products and services, and are rejected based on the rationale as noted above.

Pertaining to Claim 17

Ruffin and PR Newswire teach the use of logic to systematically analyze the prospective customer's framework for the purpose of proffering a product or service solution (see at least col. 6, line 62 through col. 7, line 3), and is rejected based on the rationale as noted above.

2.   **Claims 5-6 and 13-14 are rejected under 35 USC 103(a) as being unpatentable over Ruffin (Paper #10, US 6,249,769) and PR Newswire (Paper #20050512, PTO-892, Item: U), as applied to Claims 1 and 9, further in view of Official Notice (Paper #20, admitted prior art regarding IT business services, hereinafter referred to as "ON1").**

Ruffin and PR Newswire teach all the above as noted under the 103(a) rejection and teach a method of providing solutions for IT services (e.g. network computing, e-business, ERP, enterprise business analysis), but do not disclose a full suite of IT services as subsets to these IT services. This examiner takes the position that it is old and well-known for IT services companies to offer, individually or in a business alliance capacity, a suite of IT business services as described in the instant claims. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Ruffin and PR Newswire to disclose a suite of business services to support IT clients as taught by ON1, in order to serve as a comprehensive source for IT services, and thereby keep a foothold in the customer's business and increase sales.

Pertaining to Claims 13-14

Ruffin and PR Newswire teach the use of software running on a computer to automate the selling of products and services, and are rejected based on the rationale as noted above.

3.   **Claims 7 and 15 are rejected under 35 USC 103(a) as being unpatentable over Ruffin (Paper #10, US 6,249,769) and PR Newswire (Paper #20050512, PTO-892, Item: U), as applied to Claims 1 and 9, further in view of Official Notice (Paper #20, admitted prior art regarding techniques to provide visual clarity to illustrations, hereinafter referred to as "ON2").**

Ruffin and PR Newswire teach all the above as noted under the 103(a) and teach a method of visually presenting to a prospective customer using indicia coding techniques to provide visual clarity to the illustration (e.g. textual coding, solid line coding, black color coding for lines, symbols to code different lines), but do not disclose texture coding and shading coding. This examiner takes the position that texture coding and shading coding are old and well-known techniques for providing visual clarity in displaying illustrations or graphs. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Ruffin et al. and PR Newswire to use texture and shading coding as taught by ON2, in order to provide visual clarity to

the illustration, and thereby help the customer to better comprehend the proffered

solution.
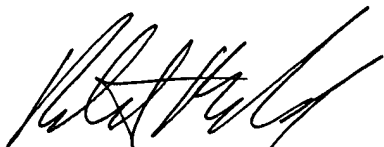
Pertaining to Claim 15

Ruffin and PR Newswire teach the use of software running on a computer to

automate the selling of products and services, and is rejected based on the

rationale as noted above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Pond
Primary Examiner
November 15, 2005